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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,824	04/24/2006	Jialin Wu	CPALP003	7398
22434	7590	01/04/2011	EXAMINER	
Weaver Austin Villeneuve & Sampson LLP			DESAI, RITA J	
P.O. BOX 70250				
OAKLAND, CA 94612-0250			ART UNIT	PAPER NUMBER
			1625	
			NOTIFICATION DATE	DELIVERY MODE
			01/04/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@wavsip.com

## Office Action Summary

Application No.

10/559,824

Applicant(s)

WU ET AL.

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/8/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 77-79, 83 and 84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7-11, 14, 16-24, 27, 28, 37, 38, 40-51, 61-64, 67, 68, 76 and 85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/8/10</u>   | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 1,3-5,7-11,14,16-24,27,28,37,38,40-51,61-64,67,68,76-79 and 83-85.

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### **DETAILED ACTION**

Claims 1, 3-5, 7-11, 14, 16-24, 27, 28, 37, 38, 40-51, 61-64, 67, 68, 76-79, 83, 84 and 85 are pending in the application.

Claims 77-79, 83 and 84 are withdrawn from consideration.

Claim 85 is new.

Response to the arguments:-

Regarding the restriction:-

Applicants have amended the claims to remove the R5 and also the X.

Thus now the R5 and X both do not exist.

This also indicates that there is no charge on the N atom.

The rejection under 35 USC 102 has been withdrawn as applicants have provisos out the compounds of the prior art.

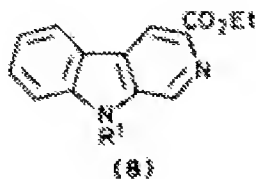
The rejection under 35 USC 103 over BE 612725 Leonard or Ishida Junko et al or WO 97/37658 ( Spenelli et al ) still stands. Applicants argue that they have amended the claims to delete the R3 to be methoxy, as the prior art compounds have the methoxy group, however the claims still have the alkoxy groups for one and also the it unclear how applicants say that the prior art have to have the methoxy group.

BE 612725 teaches compounds that do not have to have an alkoxy. Applicants claims can have R3 to be an H. or a C1-C6 alkoxy.

It is unclear how the deletion of R3 being a methoxy overcomes the rejection.

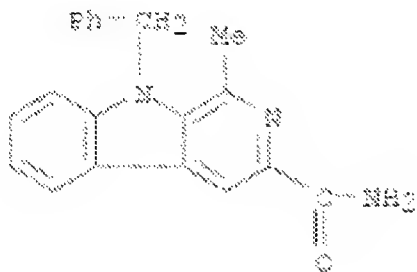
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The compound as claimed in claim 85 differs only by 2 carbons. And hence is a homologue.



See Moody Christophers compound.

Even Leonards compounds do not have a methoxy.



So applicants arguments that the prior art compounds have to have the methoxy is not convincing.

Alkyl homologues are per se obvious. In re Shetty, 195 USPQ 753, In re Wilder, 195 USPQ 426, and Ex parte Gresham, 121 USPQ 422 all feature a compound with a two carbon link rejected over a compound with a one carbon link. Similarly In re Chupp, 2 USPQ 2<sup>nd</sup> 1437 and In re Coes, 81,USPQ 369 have a one-carbon link unpatenable over a two-carbon link. Ex parte Ruddy, 121 USPQ 427 has a three-carbon link unpatenable over a one-carbon link. Ex parte Nathan, 121 USPQ 347 found the insertion of an ethylene linkage obvious. The variation was per se obvious in all these cases and did not require a specific teaching.

So the rejections have been maintained.

New rejections :-

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim s 9-11, 24, 44-46, 62, 64, 67, 68, recites the limitation "of the salt" in claim 1 the term X is now absent . There is insufficient antecedent basis for this limitation in the claim.

All the different salts have been deleted.

Claim 24 recites R4 to be an hydrogen, but the definition of R4 is an C6-C10arylalkyl or a mono or multi substituted C6-C10arylalkyl.

Correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1, 3-5, 7-11, 14, 16-24, 27, 28, 37, 38, 40-51, 61-64, 67, 68, 76 and 85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The term “pharmacologically acceptable salts” has been added in claim 1. It was not there as originally presented nor has the applicants shown its support in the specifications.

The term X has been deleted as the elected species did not read on the elected group.

It is confusing as applicants elected species did not have an "X" and the original claims did not have pharmaceutical acceptable salts thereof either.

### Conclusion

Claims 1, 3-5, 7-11, 14, 16-24, 27, 28, 37, 38, 40-51, 61-64, 67, 68, 76 and 85 are rejected.

Claim 77-79, 83 and 84 are withdrawn.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/  
Primary Examiner, Art Unit 1625

December 28, 2010.